

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

#19
1/16/03

In re application of: Kristopher T. Kohl
U.S. Serial No.: 09/658,907
Filed: September 11, 2000
For: CLOSED LOOP ADDITIVE
INJECTION AND MONITORING
SYSTEM FOR OILFIELD
OPERATIONS

§ Appeal No. _____
§ Group Art Unit: 3753
§ Examiner: R. Krishnamurthy
§ Docket No. 194-13026-CIP
§ Date: December 31, 2002
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BOARD OF PATENT APPEALS
AND INTERFERENCES

REPLY BRIEF FOR APPELLANTS (37 CFR §1.193)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Appellants hereby submit their reply brief in response to the Examiner's
Answer as mailed 10/31/02.

The fees required, if any, and any required petition for extension of time
for filing this brief and fees therefor, are dealt with in the accompanying
Transmittal of Reply Brief.

This Reply Brief is transmitted in triplicate.

The final page of this brief bears the attorney's signature.

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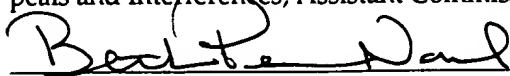
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37 CFR §1.10 on the date indicated above and is addressed ATTENTION: Board of Patent Ap-
peals and Interferences, Assistant Commissioner for Patents, Washington, D.C. 20231.



12-31-02
Date

Reply to the Examiner's Answer

The Appellants wish to specifically rebut two issues raised by the Examiner in the Answer filed 10/31/02. The first of these issues is the characterization of the Merritt reference (US 4,721,158). In the answer, the Examiner makes two statements that are in error. The first is at page 9 wherein the Examiner states that

While "flooding" may be mentioned, it is clear that the fluid at 12 is added to the wellbore production fluid. Such added fluid clearly treats the wellbore fluid as an additive would.

This is clearly in error. In each independent claim of Merritt, there is a limitation to pressure. A pressure limitation does not make sense in trying to control the injection of an additive into a producing well, only in regard to injection flooding fluids. The additives of the present invention are injected in small quantities, from 1-10,000 ppm, of the fluid being produced. The addition of such a small amount of material could not cause a pressure issue within the wellbore. The pressure issues being addressed by the Merritt reference relate to the fact that an excessive injection pressure can cause damage to the formation into which the flooding fluids are being injected.

In the answer at page 10, the Examiner states that: "In a like vein, in Merritt, Jr.et.al. fluid at 12 is injected into **the well** to enhance production of the fluid from **the well**." (Emphasis added.) This, too, is clearly not correct. In a flooding application, it is practiced to inject chemicals into a wellbore, but those chemicals are used to treat the formation and any residual oil or gas therein, not the fluid within the wellbore. The purpose of the well is to get fluid, with or without other chemicals, into the formation to reinvigorate the formation. While there are some instances of the same well being used for flooding and then "turned around" and used to withdraw additional formation fluid, it is a much

more common practice that an injection well is either drilled for the purpose of making injections or, much more likely, the injection well is a non-producing well. This makes sense as there are usually several wells drilled into a producing formation. As wells near the edge of the formation go dry, they are perfect candidates for injection. They are already drilled to and perforated at the producing strata.

The Examiner makes much of the fact that Merritt reference does not state explicitly that it relates to flooding and nothing but flooding, but patent references rarely are so explicit. As drafting practitioners, we are more concerned with being enabling for the subject matter that we are actually claiming than in putting a disclaimer to irrelevant subject matter. While the Examiner can state that the Merritt reference, if viewed in certain fashion, is to a more general field than just flooding, it does not change the fact that one of ordinary skill in the art would perceive Merritt just as the Appellants and conclude that the Merritt reference relates to flooding, not injection of additives as does the present invention.

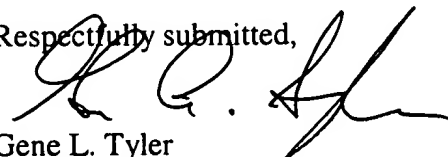
The second issue is in regard to the statements made by the Examiner regarding the declaration of commercial success. In the answer, the Examiner seems to indicate that the only basis for claiming financial success is to show that the invention has acquired some portion of market share. The Appellants disagree. While a showing of capturing a market from a competing technology would be a "slam dunk," acceptance of a new product such as the present invention is also proof and should be considered. The new products sales already exceed a quarter million dollars and are responsible for the sale of millions of dollars in additives. This is clearly financial success.

The Examiner further makes an argument that no nexus is established between the invention and the financial success, but that too is in error. As was stated in the prosecution, the present invention has the advantage over the prior art that has not been used in that it works. That is, it is reliable and prevents the economic waste of either under or over treating production fluids. The present invention is being placed into applications where no additives were previously used. While this is not a "capture" of market share, it is a creation of a market, which is sometimes even more valuable as often one competes with one's self as obsolete systems are replaced with newer systems.

PRAYER FOR RELIEF

It is respectfully submitted that the rejections of the claims have been overcome and/or avoided by the arguments presented above and in the Appeal Brief. It is further respectfully requested that the Board reverse the final rejections of the Examiner. The Examiner and/or the Board are encouraged to call the Appellants' attorney at the number below for any reason that may advance prosecution of the case.

Respectfully submitted,



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